



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/526,675

09/26/2005

Valerie De la Poterie

08048.0067

3249

22852

7590

09/03/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

09/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/526,675	<b>Applicant(s)</b> DE LA POTERIE ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-119 is/are pending in the application.
- 4a) Of the above claim(s) 54-59 and 88-119 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-53 and 60-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/2005; 08/17/2006; 02/08/2007; 12/05/2008;</u>           | 6) <input type="checkbox"/> Other: _____                          |
| <u>12/05/2008.</u>   |   |



Art Unit: 1619

### **DETAILED ACTION**

Receipt is acknowledged of election filed on 6/15/09 and IDS filed on 10/20/2005; 08/17/2006; 02/08/2007; 12/05/2008 and 07/17/2009. claims 1-119 are pending in the application.

#### ***Election/Restrictions***

Applicant's election with traverse of group I in the reply filed on 6/15/09 is acknowledged. The traversal is on the ground(s) that the present claims share the common technical relationship of a composition comprising "up to 20% by weight of water and/or of water-soluble solvent relative to the total weight of said composition; at least one wax in an amount of greater than 3% by weight relative to the total weight of said composition; and at least one volatile oil in an amount such that the total volatile oil content is less than or equal to the solids content of said composition ." See, e.g., claim 42. See M.P.E.P. § 1893.03. Accordingly, Groups I-VI should be rejoined. This is not found persuasive because as explained in the lack of unit claim 42 does not share a special technical feature as claim 42 is obvious over the combination of patents '420 and '407.

The requirement is still deemed proper and is therefore made FINAL.

Claims 88-119 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/15/09.

Applicants' election of carnauba wax is acknowledged with traverse.

Art Unit: 1619

Claims 54-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 6/15/09.

Claims 42-53 and 60-87 are examined in the application. The generic claims will be examined to the extent that it reads on the elected species drawn to “wax” only.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-53 and 60-87 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 7,211,244 (‘244).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

See col.12, ll 8-54 for volatile oil and the amount of volatile oil ( claims 45-51); see col.13, ll 58-65 for wax and melting point of wax ( claims 52-53 and 60-61); see col.14, line 12 for elected species carnauba wax and see col.14, ll 27-30 for particle size of wax and this reads

Art Unit: 1619

on carnauba micro wax; see col.14, ll 45-50 for weight percent of wax ( claims 62-64) ; see col.9, line 20 through col.10, ll 50-52 for polymer ( claims 65 and 70-71) see col10, ll 50-52 for vinyl acetate/ vinyl stearate and vinyl acetate/allyl stearate therefore claims 66-69 are inherent; see col6, ll 61-65 for weight percent of adherent polymer (claims 72-73); see col.15, line 59 for “ anhydrous composition ( claim 73); see col.11, l 55 through col12, line 2 for water soluble solvent ( claims 75-78). See col.11, ll 19-31 for dyes ( claim 80); see col.15, ll 46-55 ( claims 81-82); see col12 line 58 through col.13, line 57 for non-volatile oil ( claims 83). Patent teaches mascara compositions using the same ingredients claimed therefore claims 84-85 are inherent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/526,675

Page 5

Art Unit: 1619

/JYOTHSNA A VENKAT /

Primary Examiner, Art Unit 1619